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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,304	08/04/2003	Noam Babayoff	25628	3435
20529	7590	03/23/2005	EXAMINER	
NATH & ASSOCIATES 1030 15th STREET, NW 6TH FLOOR WASHINGTON, DC 20005				GABOR, OTILIA
			ART UNIT	PAPER NUMBER
			2878	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/633,304	BABAYOFF ET AL. <i>(PM)</i>
	Examiner Otilia Gabor	Art Unit 2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 04 August 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All
    - b) Some \*
    - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                         |                                                                             |
|---------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                    | Paper No(s)/Mail Date. _____.                                               |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/09/03, 12/30/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                                                         | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: (12), (14). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1-3, 6-16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hamann (U. S. Patent 6,449,042).

Regarding claims 1 and 13 Hamann discloses an apparatus and method for imaging a non-flat specimen (rough surface), the apparatus having an optical axis (b) (see Figs.3-7) and a predetermined lateral resolution, the apparatus comprising: a coherent light source (5) for producing a light beam (6, 1); imaging optics (2) adapted to focus the light beam (6, 1) into at least one spot (3) on a surface of the specimen (see Fig.3 and 6a); and a detector (11) having an integration time and adapted to receive and detect light (9, 4) reflected from the surface of the specimen; where the imaging optics (2) comprises at least one optical component (one or more plano-convex lens or achromats or aspheres or optics with multiple elements) so that the light reflected (9, 4) from the specimen passes therethrough (see Figs.3,5) on its way to the detector (11); and where the optical component (2) is movable so as to move the at least one spot (3) within a range of movement, to a number of distinct location in a plane perpendicular to the optical axis (b), within the integration time of the detector (11) (i.e., through the rotating movement of the lens (2) the spot (3) is carried through a complete circle in a plane that is perpendicular to axis (b)(see Figs.3, 6a)).

Regarding claims 2, 3, 6-10, 15, 16 Hamann discloses that the optical component is any type of optical lens (see Col.4, lines 17-30) which, inherently includes a non-imaging transparent, glass (usually lenses are made of glass) objective lens which could have a wedge shape (see Fig.3) and which is adapted to move circularly

about the optical axis (b) through which movement the optical component produces a circular spot pattern (c) on the specimen (see Figs.1-6, Col.4, lines 1-50).

Regarding claim 11 Hamann discloses that the light beam is composed of multiple light beams (see Col.3, lines 64-67).

Regarding claim 12 Hamann discloses using a beam-splitter (20) (see Fig.7).

Regarding claim 14 Hamann discloses that the optical component (2) can not only be rotated around the optical axis (b) and thus moved on one axis but it can also move closer or further away from the specimen (see Fig.5 and Col.4, lines 31-50) and thus it can move on a second axis (thus dual axis movement possible).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamann.

Regarding claim 4 Hamann fails to specifically disclose that the moving optical element (2) is a reflecting optical element; however since he discloses that any other possible optical elements can be used for the movable optics it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a reflecting optical element since such elements (i.e., a mirror) is well known and conventionally used optical element in this field, and thus substituting one for the other is an obvious feature to one having ordinary skill in the art.

The limitations of claim 5 were addressed in the above paragraphs.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Stern (6,545,264); Psaltis et al. (US 2004/0021871 A1); Morimoto et al. (5,046,795).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Otilia Gabor whose telephone number is 571-272-2435. The examiner can normally be reached on Monday, Thursday-Friday between 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on 571-272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Otilia Gabor  
Examiner  
Art Unit 2878

